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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,462	02/28/2002	Tomohiro Koyata	7217/66559	1812
530 7590 02/16/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/085,462	Applicant(s) KOYATA ET AL.	
	Examiner Bradley B. Bayat	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on November 24, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-11, 13-17, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-17, 27 and 28 is/are rejected.
- 7) ☒ Claim(s) 1 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

This communication is in response to amendment filed on November 24, 2006. Claims 1 and 11 have been amended and new claims 27 and 28 have been added. Claims 1, 3-11, 13-17, 27 and 28 remain pending.

Response to Amendment

The amendment filed on 11/24/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material in claims 1 and 11 which is not supported by the original disclosure is as follows: "...wherein when said additional service is offered to said customer, said controlling means deletes said encoded digital data from said storage medium." The examiner has reviewed the specification, but was unable to find support for the amended subject matter.

Applicant is required to provide exactly where in the disclosure support for such amendment exists.

Otherwise, Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed on 11/24/2006 have been fully considered but they are not persuasive.

Applicant contends that the portion of the claim reciting, "said inquiry information being used to indicate whether the digital data was encoded or recorded in a manner consistent with the

Art Unit: 3621

digital signal processing apparatus” is not anticipated by the cited reference (response p. 10-11). Applicant concedes that Ginter provides a fingerprinting mechanism to verify the legality of the purchased data, however, indicates that the inquiry information is related to the recording characteristics of the data itself rather than “something that has been artificially added to mark the data (response p. 11).” The examiner respectfully disagrees.

Ginter discloses that “once an end user has connected to the VDE repository and authentication has occurred, the user may begin manipulating and directing their user interface software to browse through a repository content catalog 3322 (e.g. lists of publications, software, games, movies, etc.), use the search mechanism to help locate content of interest, schedule content for delivery, make inquiries of account status, availability of usage analysis information, billing information, registration and account profile information, etc. If a user is connecting to obtain content, the usage requirements for that content may be delivered to them. If the user is connecting to deliver usage information to the repository, information related to that transmission may be delivered to them [2240].”

Furthermore, Ginter discloses in paragraph 1194 that “one of the characteristics of a usage map provided by the preferred embodiment of the present invention is that the significance of a map element is specified, at least in part, by the position of the element within the usage map. Thus, in a usage map provided by the preferred embodiment, the information indicated or encoded by a map element is a function of its position (either physically or logically) within the map structure. As one simple example, a usage map for a twelve-chapter novel could consist of twelve elements, one for each chapter of the novel. When the user opens the first chapter, one or more bits within the element corresponding to the first chapter could be changed in value (e.g.,

Art Unit: 3621

set to "one"). In this simple example where the owner of the content object containing the novel was interested only in metering which chapters had been opened by the user, the usage map element corresponding to a chapter could be set to "one" the first time the user opened that corresponding chapter, and could remain "one" no matter how many additional times the user opened the chapter. The object owner or other interested VDE participant would be able to rapidly and efficiently tell which chapter(s) had been opened by the user simply by examining the compact usage map to determine which elements were set to "one." See also paragraph 1196, 1239, 1547, 1619 and 1983.

The following responses are incorporated from the examiner's previous actions:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., determination of whether the data was recorded by the same apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Determination of two compatible "encoded or recorded" formats by themselves cannot determine the origin of the recording apparatus, but merely compatibility with the apparatus. The argument forwarded by applicant is therefore not reflected in the language of the claims.

Furthermore, the encoding and recording of formats presented by applicant merely determine compatibility of one application with the originating program or one that is compatible to read such data. "Data in a file is stored in a format that is established by whatever application created the file (i.e., organized the data) and typically needs to be read by the same or similar program that can interpret the format and present the data to the user on the computer screen

Art Unit: 3621

(<http://www.webopedia.com/TERM/f/format.html>).” As such, applicant’s contention that such limitation determines whether data was recorded by the “same apparatus or another legally recognized apparatus” is without merit.

Moreover, Ginter discloses, “certain control methods that have been expressly certified as securely interoperable and compatible with said application may be independently submitted by a participant as part of such a contribution. In the most general example, a generally certified load module (certified for a given VDE arrangement and/or content class) may be used with many or any VDE application that operates in nodes of said arrangement. These parties, to the extent they are allowed, can independently and securely add, delete, and/or otherwise modify the specification of load modules and methods, as well as add, delete or otherwise modify related information [0161].

Applicant has amended the claims to overcome the rejection based on Ginter. Applicant contends that the claimed subject matter is distinguishable from the cited reference since “the information or digital data of the claims is already stored in the storage medium and the apparatus makes inquiries as to whether the stored information has been legally purchased (response p. 11).” Applicant concedes that in “Ginter et al., the paragraph 0222 discloses the transmitting of inquiry information to an information center, the inquiry information being generated in association with digital data that has been recorded on a storage medium.” Id. Applicant then contends that “this is not the same as inquiring whether the information has been legally purchased or not, wherein the information is already in the storage medium.” Id. Accordingly, the applicant concludes that in light of the amendments to the claims, the

Art Unit: 3621

distinguishing feature is "offering an additional service to a user by using encoded digital data that is already stored in the storage medium." Id.

The examiner respectfully disagrees. Ginter discloses many variations to protecting, tracking, and distributing digital information via a VDE. Applicant's feature is anticipated by the Ginter reference and is not novel in light of the art. For instance, in paragraph 0221 Ginter provides that such "information would be useful in tracking who may have "broken" the security of a VDE installation and was illegally making certain electronic content available to others. Fingerprinting may provide additional, available information such as time and/or date of the release (for example extraction) of said content information. Locations for inserting fingerprints may be specified by VDE installation and/or content container control information. This information may specify that certain areas and/or precise locations within properties should be used for fingerprinting, such as one or more certain fields of information or information types. Fingerprinting information may be incorporated into a property by modifying in a normally undetectable way color frequency and/or the brightness of certain image pixels, by slightly modifying certain audio signals as to frequency, by modifying font character formation, etc. Fingerprint information, itself, should be encrypted so as to make it particularly difficult for tampered fingerprints to be interpreted as valid. Variations in fingerprint locations for different copies of the same property; "false" fingerprint information; and multiple copies of fingerprint information within a specific property or other content which copies employ different fingerprinting techniques such as information distribution patterns, frequency and/or brightness manipulation, and encryption related techniques, are features of the present invention for increasing the difficulty of an unauthorized individual identifying fingerprint locations and

Art Unit: 3621

erasing and/or modifying fingerprint information.” As such, applicant’s amendments fail to distinguish the claimed subject matter from the cited reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-11, 13-17, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (hereinafter Ginter), US 2004/0133793 A1.

As per the following claims, Ginter discloses:

1. A digital signal processing apparatus comprising:

-transmitting means for transmitting inquiry information to an information center over a communication line, said inquiry information being generated by using at least a part of encoded digital data which have been recorded on a storage medium, said inquiry information being used to indicate whether the digital data was encoded or recorded in a manner consistent with the digital signal processing apparatus [0008, 0161, 0215-226, 0478, 0621, 0663, 1194-1196, 1239, 1547, 1619 and 1983];

-receiving means for receiving a result of an inquiry conducted by said information center based on said inquiry information [0226-0240];

Art Unit: 3621

-discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium are legally purchased data [1118, 1126, 1540, 1858, 1971-1975]; and

-controlling means which, when said discriminating means judges said encoded digital data to be legally purchased data, executes a process to offer an additional service to said customer, wherein when said additional service is offered to said customer, said controlling means deletes said encoded digital data from said storage medium [0057-0093, 0192, 0208, 0215-0222, 1194-1196, 1239, 1547, 1619 and 1983].

3. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium with an algorithm of a predetermined version, into digital data having undergone encoding with an algorithm of a more advanced version, before replacing the unconverted digital data with the converted digital data on said storage medium [0965, 1478, 1511, 2017, 2280].

4. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means restoring said digital data having undergone said predetermined low bit rate coding process onto said storage medium [0186-0191, 2064].

5. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded

Art Unit: 3621

on said storage medium into encoded digital data a different bit rate, before replacing the unconverted digital data with the converted digital data on said storage medium [2279-2321].

6. A digital signal processing apparatus according to claim 1, wherein said additional service offered to said customer comprises furnishing said customer, free of charge, with a product related to a producing party who produced said digital data purchased legally by said customer from said information center [0107-0141].

7. A digital signal processing apparatus according to claim 1, further comprising inputting means for inputting identification information for identifying said encoded digital data which are subject to said inquiry; wherein said identification information input through said inputting means is transmitted to said information center over said communication line [0193-0229].

8. A digital signal processing apparatus according to claim 7, wherein said information center comprises: receiving means for receiving said inquiry information and said identification information for identifying said encoded digital data which are subject to said inquiry transmitted from said encoded digital signal processing apparatus; retrieving means for retrieving said digital data subject to said inquiry from said information center in association with said identification information for identifying said encoded digital data; reference inquiry information generating means for generating reference inquiry information in association with said encoded digital data retrieved by said retrieving means; comparing means for comparing said reference inquiry information generated by said reference inquiry information generating means with said inquiry

Art Unit: 3621

information received by said receiving means; inquiry result generating means for generating an inquiry result based on a result of the comparison by said comparing means; and transmitting means for transmitting said inquiry result generated by said inquiry result generating means [0509, 0722].

9. A digital signal processing apparatus according to claim 8, wherein said reference inquiry information generating means subjects part of said encoded digital data retrieved by said retrieving means to an encoding process executed by a software encoder, the coded data part being compared with said inquiry information by said comparing means [1350-1814].

10. A digital signal processing apparatus according to claim 1, further comprising charging means for processing charges; wherein, if said discriminating means judges that said encoded digital data recorded on said storage medium are legally purchased data, then said charging means either charges nothing or a reduced amount to said customer for said additional service offered to said customer [0222-0272].

27. The digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means by moving said encoded digital data from said storage medium to another storage medium [1194-1196, 1239, 1547, 1619 and 1983].

Claims 11, 13-17 and 28 are directed to a method of the above-recited apparatus and are similarly rejected.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8 a.m.-6:30 p.m..

Art Unit: 3621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Bradley Bayat', with a stylized horizontal line extending from the end.

Bradley B. Bayat
Primary Examiner
Art Unit 3621